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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,227	12/06/2001	Lisbeth Hamer	2131US	7875

22881 7590 02/07/2003

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EXAMINER

SRIVASTAVA, KAILASH C

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 02/07/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n No.

10/010,227

Applicant(s)

HAMER ET AL.

Examin r

Dr. Kailash C. Srivastava

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-49 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

1. Claims 1-49 are pending.

### ***Election/Restriction***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I – Claims 1-4 and 6 drawn to a binding assay to determine binding between a test compound and 3-Isopropylmalate dehydrogenase polypeptide to ascertain inhibition of the said polypeptide by the said test compound, classified under Class 435, Subclass 7.1, for example.

Group II – Claims 5, 7, 12, 17 and 40-43 drawn to a fungal growth assay when a fungus is brought into contact with a candidate antibiotic compound to evaluate if the candidate compound has antifungal activity, classified under Class 435, Subclass 29 for example.

Group III – Claims 8-11, 13-16 and 18-19 drawn to fungal 3-Isopropylmalate dehydrogenase activity assay, classified under Class 435, Subclass 4 for example.

Group IV – Claims 20-25 drawn to a method to assay expression of fungal 3-Isopropylmalate dehydrogenase in a cell or tissue, classified under Class 435, Subclass 7.4, for example.

Group V – Claims 26-39 drawn to a method to assay comparative growth of fungus and expression of fungal and non-fungal 3-Isopropylmalate dehydrogenase genes in two different fungi, classified under Class 435, Subclass 32 for example.

Group VI – Claims 44-47 drawn to an isolated nucleotide encoding a polypeptide, classified under Class 536, Subclass 23.2 for example.

Group VII – Claims 48-49 drawn to a polypeptide, classified under Class 435, Subclass 232 for example.

3. The inventions of Groups I-VII are distinct, each from the other.

Inventions in each of the Groups I-VII are unrelated to each other because they are directed to inventions that are not connected in design, operation and/or effect. These inventions are independent since they are not disclosed as capable of use together. They have different modes of operation, they have different functions, and/or they have different effects. One would not have to practice the various inventions at the same time to practice just one invention alone (MPEP § 806.04, MPEP § 808.01). In the instant case, invention disclosed in claims encompassing invention in Group II is directed to a fungal growth assay in presence of a test compound that may have an antibiotic activity, whereas the invention of group IV encompasses claims to assay for expression of 3-Isopropylmalate dehydrogenase enzyme in a given cell or tissue. Similarly, Invention in Group III encompasses claims drawn to assaying the activity of fungal 3-Isopropylmalate dehydrogenase (also known as 3-isopropylmalate hydro-lyase, See enclosed excerpt from IUBMB Enzyme Nomenclature Classification), while invention of Group VII encompassing Claims 44-47 is drawn to a nucleotide encoding a particular polypeptide.

Inventions discussed above are independent and distinct, each from the other. They have acquired a separate status in the art as a separate subject for inventive effect and require independent searches. The search for each one of the above inventions is not coextensive particularly with regard to the literature search. Further, a reference that would anticipate the invention of one group would not necessarily anticipate or even make obvious another group. Finally the consideration for patentability is different in each case. Thus, it would be an undue burden to examine all of the above inventions in one application.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification (class/subclass), a requirement for independent search as explained above and their recognized diverse subject matter, restriction for examination purposes as indicated is proper.

4. Applicants are advised that a reply to this requirement must include an identification of an invention elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

5. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b). Any

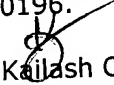
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amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

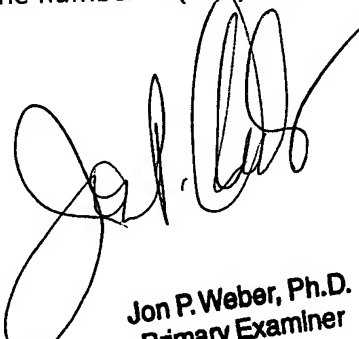
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kailash C. Srivastava whose telephone number is (703) 605-1196. The examiner can normally be reached on Monday to Thursday from 7:30 AM to 6:00 P.M (Eastern Daylight Saving, or Standard time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn, can be reached on (703) 308-4743. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

  
Kailash C. Srivastava, Ph.D.  
Patent Examiner  
Art Unit 1651

February 4, 2003

  
Jon P. Weber, Ph.D.  
Primary Examiner